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Remarks/Arguments

Claims 1-14, and 22-28 are pending in this application. For at least the reasons stated below, Applicants believe that all claims are in condition for allowance as they are not obvious over the cited prior art.

1. The Examiner has repeatedly rejected the claims based on linking five references.

In the first office action the Examiner rejected the primary independent claim under 35 USC § 103(a) as unpatentable over Sheflott in view of Tibbetts and further in view of Flores. These same references were the basis of the 103(a) rejection in the second and third office actions by the Examiner. In response to Applicants' amendments and arguments the Examiner extended the 103(a) rejection in the fourth office action by stating that the claim was unpatentable over Sheflott in view of Tibbetts in view of Flores and in further view of Elance.com.

In their fourth response, the Applicants amended the independent claims and argued that a combination of the four references would not include all of the limitations in the claims. In his fifth Office action, the Examiner rejected the independent claims with a chain of five references. Applicants responded and argued that there was no proper motivation to combine these five references and therefore the rejection was improper and should be withdrawn.

In the present Office action, the Examiner has maintained the rejections, stating that the arguments are not persuasive and asserting new motivations to combine the references.

As has just been described, over the course of prosecution, Applicants have amended the primary claims several times to clarify the invention in light of the cited references. Applicants have also argued that the references do not teach all of the elements of the claims, and that even if they did, the references do not suggest any motivation to combine the bits and pieces from all five references in order to teach the invention as claimed. As these rejections have been maintained multiple times, Applicants will not address them once again at this time. Applicants maintain their objections to the rejections and will argue these points on appeal.

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2. The Examiner has repeatedly ignored Applicants' arguments for claim 2.

The Examiner has repeatedly ignored Applicants request for clarification for the rejection of claim 2. Claim 2 reads simply as: "A method as recited in claim 1, wherein the service provider data structures include data concerning contract service providers." In other words, claim 2 generally adds to the independent claim the limitation of a certain data structure that stores data about certain service providers. The Examiner's rejection of this claim has been very confusing.

In the first office action (dated 6/11/2002), the Examiner rejected claim 2 on the basis that: "Sheflott teaches ... the step of matching the user to a service provider includes **optimization services** (Fig 3/101/100/90)." Applicants responded (9/11/2002) to this rejection by pointing out claim 2's sole limitation over claim 1 is "data structures [including] data [about] contract service providers", and that such a data structure has no relationship to optimization services.

In his second Office action, the Examiner maintained the rejection of claim 2, stating that "Sheflott teaches ... the step of matching the user to a service provider includes **optimization services** (Fig 3/101/100/90). Tibbetts teaches coordinating actions between proposal and any consumer, which leads to optimizations (Fig 6/603)(Fig 7). Flores teaches workflow management and workflow schedule processing (Fig 2) and performance optimization (Fig 1) and satisfaction optimization (Fig 3)." The Examiner then said that it would have been obvious to combine the references to apply these cited techniques to a contract manufacturing environment and the motivation to combine "analyzing and structuring business processes that provides clients with the requisite tools to manage these businesses efficiently as enunciated by Flores".

Thus, for the second time, claim 2 (which is directed to data structure for holding data about service providers) was rejected on the basis of a teaching of "optimization services" which allows management of businesses efficiently. Regrettably, this rejection does not make logical sense to Applicants. In Applicants' response (5/23/2003), Applicants again pointed out the contents of claim 2 and stated that "the contentions by the Examiner [that this claim is about optimization services] ... do not bear on claim 2 as written".

In his third Office action (6/17/2003), the Examiner maintained his rejection of claim 2 because "Sheflott teaches a method ... wherein the step of matching the user to a service provider includes **optimization services** (Fig 3/101/100/90)." Thus, the Examiner rejected claim 2 for the third time on the basis that Sheflott teaches optimization services.

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For the third time, the Examiner did not explain why he feels teaching optimization services reads on "service provider data structures include data concerning contract service providers". In its response to this Office Action (filed 10/15/2003), Applicants pointed out for the third time that the Examiner has not explained why the Examiner believes "optimization services ... have any bearing on claim 2" since claim 2 is not about optimization services.

In his fourth Office action (11/3/2003), the Examiner maintained his rejection of claim 2, stating simply that "Sheflott teaches ... the step of matching the user to a service provider includes **optimization services** (Fig 3/101/100/90)." The Applicants filed their fourth Response (1/5/2004) in which claim 1 was amended. The question about why a rejection about "optimization services" has anything to do with claim 2 was not repeated for the fourth time since the Examiner had failed to address the issue for three times already and since the amendment to claim 1 was believed to be allowable over all of the cited art.

In his fifth Office action (2/19/2004), the Examiner again rejected claim 2 on the basis that Sheflott teaches "matching the user to a service provider includes **optimization services** (Fig 3/101/100/90)". In its response (5/19/2004), the Applicants approached the problem of the rejections from a new vantage point, arguing that the Examiner's use of five references without a plausible motivation to combine the five references was not enough for a proper 103 rejection.

In his sixth Office action (9/1/2004), which is now before us, the Examiner rejected Applicant's argument that the motivation to combine the references was improper. The Examiner also said that "The rejections as cited in the Non-Final Office Action are ... maintained."

As a result of these six office actions, the Applicants are presently in the position of defending claim 2 against a nonsensical rejection. Applicants have explicitly asked three times why "optimization services" teaches "data structures including data concerning contact service providers". There has been no explanation whatsoever from the Examiner.

The Examiner has failed his examination duty. The MPEP states that "to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application" MPEP § 707.07(f) (emphasis added). Furthermore, "the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it" MPEP § 707.07(f). In response to Applicants' requests for clarification, the Examiner has stated that the Applicant's arguments have been fully

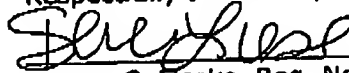
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considered but they are not persuasive. This cursory response does not "include a rebuttal of any arguments raised in the Applicant's reply" or clearly develop the grounds of rejection "to such an extent that applicant may readily judge the advisability of an appeal" as required by MPEP § 706.07. Accordingly, the Examiner in his Office action has failed to establish a valid final rejection, and Applicants respectfully request a rebuttal to the above arguments that claim 2 does not relate to "optimization services". In the alternative, Applicants request concession of the above arguments and removal of the finality of the rejection.

3. Summary

Since the rejections to the Independent claims have been addressed, Applicants submit that all pending claims are in condition for allowance. Applicants respectfully request reconsideration of the claims and ask that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7508. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Attorney Docket # 060021-358401).

Respectfully submitted,



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